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NIKOLAI & MERSEREAU, P.A. 900 SECOND AVENUE SOUTH SUITE 820 MINNEAPOLIS, MN 55402			MARKS, CHRISTINA M	
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			3713	

DATE MAILED: 07/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/937,961

Applicant(s)

DONALD ET AL.

Examiner

C. Marks

Art Unit

3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-16 and 18-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-16 and 18-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 August 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date May 07 2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

The objection to the Information Disclosure Statement has been withdrawn due to the filing of an additional statement on 07 May 2004.

Drawings

As per the Applicant's request, the Examiner will identify the claims from which the drawing objections were drawn. The objections include the "player card containing pre-recorded biometric data (claim 1)", "croupier card containing pre-recorded biometric data (claim 6)", "chip card with a fingerprint reader (claim 1)", "a chip card with a microprocessor, two storage registers, and a memory (claim 1)", and "transfer funds to and from separate accounts held by one or more casinos (claim 29)".

In response to the Applicant's argument that these items are shown the Examiner respectfully disagrees with the above listed items and concurs about the comparator and pop-up screens and has thereby withdrawn the objections to those elements. Regarding the player card with pre-recorded data, the chip card with fingerprint reader, and the chip card with two storage registers were all identified by item 47 in FIG 1. However, this identification is not convincing to properly illustrate this feature as it is identified by the Applicant as a smart card with microprocessor and the rest of the items are still absent, thus not properly illustrated. Regarding the croupier card, it is shown but the pre-recorded biometric data is not identified to be stored within. Finally, regarding the transfer of funds to and from separate account, the illustration only shows a one-way transfer to a casino fund account from an EFT, not the two-way transfer through separate accounts.

Thus, The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "player card

Art Unit: 3713

containing pre-recorded biometric data (claim 1)", "croupier card containing pre-recorded biometric data (claim 6)", "chip card with a fingerprint reader (claim 1)", "a chip card with a microprocessor, two storage registers, and a memory (claim 1)", and "transfer funds to and from separate accounts held by one or more casinos (claim 29)" must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

Art Unit: 3713

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 3-5, 11-13 and 27, are rejected under 35 U.S.C. 103(a) as being unpatentable over Vuong et al. (US Patent No. 5,762,552) in view of Stock et al. (US Patent No. 6,011,858).

Vuong et al. discloses a gaming system where multiple players linked over a communication system can access a game played remotely (Abstract) against a casino or in the case of table games, other players. The player are provided with a remote video game machine that can accept a card to represent a wager (Abstract) that serves as a player card interface to read card data and is a purse to the player in the sense that the player is allowed to access it to complete monetary transactions. Each player station card interface can access a plurality of casino stations representing a plurality of games controlled by croupiers, as they are live games (Abstract). The broadcast of the game on the gaming machine is of quality feed comprising both audio and video signals (Abstract), thus displaying and receiving information. Once a game is selected, the player is presented with a video representation of the possible bets on the gaming machine and can use their card to place the bet (Abstract) and transmit the bet. Once the bet is placed, it is recorded in a register in memory (Abstract). At the end of the game, if the bets placed by the players are determined to be winners, the appropriate winnings are calculated and returned to the player as a credit on their account. If the bets are not winning, the appropriate deductions are made from the credit account. (Abstract). Credit accounts are

Art Unit: 3713

used to pay if the gaming machine is disposed in a remote location as it is impractical to collect currency from widely distributed locations (Column 2, lines 66-67; Column 3, lines 1-2). As Vuong et al. disclose, a number of player are involved (Column 1, lines 5-10), thus the system would permit communication among them in the form of allowing multiple player to communicate with each other via betting within the same game and having the ability to access said game.

However, though Vuong et al. makes essential a purse with the credit card system, Vuong et al. do not disclose the usage of an actual smart card with a purse that is granted access on the basis of biometric parameters.

Stock et al. discloses an alternative to conventional credit card transaction (Column 1). Stock et al. disclose that the use of smart cards has greatly increased for financial transactions (Column 1). Stock et al. further discloses a memory card for holding personal information (Column 3, lines 62-63). Stock et al. disclose a security file structure that allows a biometric template to be obtained and stored on the card. In order for the user to access the card, biometric verification must first occur. Stock et al. also provide a motivation for using a biometric protected card over conventional credit cards. Stock et al state that currently, commercial credit card transactions are handled in a manner that provides only a minimum level of security (Column 1, lines 12-15). Further, Stock et al, defines an ever-increasing need for strengthened security measures to adequately protect users as EFT continues in grown and further teaches that by using strengthened security measures, such as biometrics, to adequately protect users of cards, the user would then feel comfortable using the cards for a wider range of activities including credit card and bank accounts (Column 2, lines 29-35). Stock et al. also disclose that the card can be used on POS terminals with a memory reader that would extract a biometric template and compare it to a current template and if it determines the user is the true

Art Unit: 3713

holder, access to cash accounts on the memory card will be accessed and debited to cover the purchase (Column 7, lines 37-48). In this manner, the card serves as a debit purse (Column 4, line 38).

It would have been obvious to one of ordinary skill in the art to incorporate the teachings of Stock et al. into the system of Vuong et al. One of ordinary skill in the art would be motivated to do this because firstly Vuong et al. already accepts credit cards so the incorporation of a smart card would have been an obvious adaptation over the allowance of credit cards. Secondly, one would be motivated to do this because as disclosed above by Stock et al. the user has a higher level of comfort using a card with a strengthened security measure. By incorporating the teachings of Stock et al. regarding biometric identification to access purses into the system of Vuong et al., the ever-increasing need for strengthened security measures to adequately protect EFT users would be realized in the system of Vuong et al. thus creating a greater level of user comfort while at the same time providing a more secure system wherein the cards could not be unlawfully obtained or used.

Regarding claim 4, Vuong et al. disclose a network manager that serves as a croupier as it is a medium between the player and the game (Column 7, lines 66-67; Column 8, lines 1-26). The network manager serves as a croupier by participating in the game by accepting bets. Further, the croupier is in charge of checking credit and establishing connections (thus receiving the amount of money bet and transferring the money for the bet) and account balances. It thus is computer based and is connected to the player stations. The network manager can also access casino funds as it credits winning players (Abstract).

Regarding claim 5, the network disclosed by Vuong et al. is embodied as being capable of being an ISDN network (Column 5, lines 25-30).

Art Unit: 3713

Regarding claim 11, Stock et al. disclose that the transfer of money is based upon access to financial institutions through electronics financial transactions. Stock et al. disclose that the memory card for biometric data contains applications that can include financial transactions including bank information, thus facilitating and EFT thus creating a purse account for the player that is accessed through a bank. Separate purse accounts are known in the art and would have been obvious as an obvious design choice over the number of currently available biometric smart cards.

Regarding claims 12, Stock et al. discloses that all access on the card is contingent upon biometric verification (Column 4, lines 55-62).

Regarding claim 13, Vuong et al. only disclose that bet information is sent to the croupier. Hence, the croupier would not be able to garnish the actual identity of a person from that information alone. Further, by not allowing such access, the protection of the user information is further enhanced.

Regarding claim 27, the structure of the system has been disclosed above and in view of the combination made, it would be obvious to one of ordinary skill in the art that the system would require a chip card reader and biometric reader to enable the smart card disclosed by Stock et al.

Claims 6-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vuong et al. (US Patent No. 5,762,552) in view of Stock et al. (US Patent No. 6,011,858) further in view of Gressel (US Patent No. 6,311,272).

What Vuong et al. and Stock et al. disclose, teach, and/or suggest has been discussed above and is incorporated herein.

Art Unit: 3713

The combined disclosed of Vuong et al. and Stock et al. teaches of a gaming station that allows the use of biometric smart cards to facilitate transactions. Vuong et al. disclose the use of such a card on the croupier station.

However, Vuong et al. in view of Stock et al. do not disclose the use of such a card on the croupier station.

Gressel discloses a system where access is conditional upon a player employing an electronic purse (Column 15, lines 66-67; Column 16, lines 1-3) in a player chip-card with pre-recorded biometric data (Column 3, lines 65-67; Column 4, lines 11-17). Access to the services is further conditional upon a matching of the biometric data derived from the player with pre-recorded data (Column 1, lines 35-48). Following access being granted, the monetary transactions are enacted using the player purse (Column 15, lines 66-67; Column 16, lines 1-3). Furthermore, Gressel includes a reader/recorder interface provided to read data from the smart card (FIG 1A, reference 20) at the time of intended access and for matching the read data to pre-recorded data (Column 1, lines 49-54). Access is terminated when the user is complete with the transaction and removes the smart card from the terminal (Column 14, lines 16-20).

Hence, Gressel disclose a system where a chip card is used to make financial transactions and includes an electronic purse (Column 15, lines 66-67; Column 16, lines 1-3). The chip card includes means to make sure communications are safe (Column 2, lines 27-30; Column 4, lines 26-30) as well as using a suspect listing that keeps track of various system integrity issues (Column 14, lines 42-44). The system issues a card from a supplier that undertakes the initial biometric identification and records the biometric data in the card (Column 3, lines 50-67; Column 4, lines 1-17). The employee that grants access is also required to use a biometric identifying in order to access the system (Column 3, lines 50-60), thus further

Art Unit: 3713

protecting the validity of the system by requiring the employee to biometrically verify themselves before allowing any access or transactions on the system.

It would have been obvious to one of ordinary skill to incorporate the teachings of Gressel relating to requiring the employee to biometrically be verified into the system of Vuong et al. in view of Stock et al. One of ordinary skill in the art would be motivated to make this incorporation in order to provide even further data security to the systems of Vuong et al. and Stock et al. as disclosed to be highly desirable by Stock. By requiring the employee, the croupier, disclosed by Vuong et al. to use a card that is biometrically verified to participate in the gaming session, the security of the system would be greatly enhanced and therefore more desirable. By implementing this requirement, fraudulent use would be prevented by being able to positively verify which employee performed which transactions as well as preventing unauthorized users from assuming the role of the croupier.

Regarding claim 8, Gressel teaches of encrypting and decrypting the signals related to the smart card purse to further enhance its security ((FIG 6A).

Regarding claim 9, one of ordinary skill in the art understands one of the associated principles of encryption is to also be able to track unauthorized attempts, as is notoriously well known in the art in gaming system to further enhance the security relating to the highly lucrative industry. Along with the encryption disclosed by Gressel, the system of Vuong et al. also includes means and measures to ensure the system integrity including an alarm in the form of a disconnection if a security violation occurs in the system (Column 9, lines 27-35). While what comprises a security violation is not explicitly named by Vuong et al., such an attempted encryption breaking defined above are well known in the art to be flagged security violations and thus would have been obvious to further implement the teaching of Vuong et al. to cause a lock out at this point.

Art Unit: 3713

Regarding claim 10, the system of Vuong et al. also includes means and measures to ensure the system integrity including an alarm in the form of a disconnection if a security violation occurs in the system (Column 9, lines 27-35). While what comprises a security violation is not explicitly named the disclosed security violations by the Applicant are well known in the art to be flagged security violations and thus would have been obvious.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Vuong et al. (US Patent No. 5,762,552) in view of Stock et al. (US Patent No. 6,011,858) further in view of Harkin (WO 99/28701).

What Vuong et al. and Stock et al. disclose, teach, and/or suggest has been discussed above and is incorporated herein.

Vuong et al. does not disclose the card being able to read the biometric data itself.

Harkin teaches of another similar smart card to the one disclosed in the combination of Vuong et al. and Stock et al. The card of Harkin incorporates a sensor on the card to actually compare the biometric parameter to that of the one stored within the cards memory (Abstract). Harking further teaches such a sensor is desirable to fit on small devices. Harkin discloses that such sensing is compact and relatively expensive (page 2) and can be a substitute to the conventional optical image sensing which can be bulky and expensive.

It would have therefore been obvious to one of ordinary skill in the art to incorporate a sensor as disclosed by Harkin into the card disclosed by Stock et al. for use in the Vuong et al. system. One of ordinary skill in the art would be motivated to make this incorporation in order to reduce the amount of hardware required at each station for both the player and the user by using the sensor disposed within the card itself which as taught by Harkin is relatively

Art Unit: 3713

inexpensive. Thus, an operator could eliminate the need to install, test, and maintain the sensors on every machine.

Claims 15-16, 18-26 and 28-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vuong et al. (US Patent No. 5,762,552) in view of Stock et al. (US Patent No. 6,011,858) further in view of Gressel (US Patent No. 6,311,272) further in view of Crevelt (US Patent No. 5,902,983).

What Vuong et al., Stock et al. and Crevelt disclose, teach, and/or suggest has been discussed above and is incorporated herein.

Gressel taught the importance of encrypting data in a card system. None of the above references disclose placing limits on the spending of the player via the credit accounts. However, such limits are well known as a means to not allow a player to access an entire account or credit line during gambling. This concept is also disclosed by Crevelt et al. Crevelt et al. states that with unlimited access to funds, a small minority of susceptible individuals will tend to overextend themselves and by allowing such individuals to have direct and easy access to their entire bank accounts could be financially ruinous (Column 2, lines 19-22). Thus Crevelt et al. discloses setting limits upon the players to allow the player's to use a smart card, but at the same time not allow an over-extension of their budgets (Column 2, lines 31-37). Thus, the incorporation of any control data aimed at keeping people from over-extending their budget would have been obvious to the system of Vuong et al. as disclosed by Crevelt et al. as a means to protect against rash decisions by some player to divert large amount of their savings to gaming (Column 2, lines 25-30).

Art Unit: 3713

Regarding claim 28, it would be obvious to the encrypted disclosure of Crevelt that the encrypted data would be associated with an encrypted register designed to not allow hackers or intruders to access the data.

Regarding claim 19, the method to realize the system disclosed above would have been obvious to the disclosure of Vuong et al. in view of Stock et al. One of ordinary skill in the art would understand based upon the systematic disclosure above, that the card must be read by the reader incorporated with the station in order to access the money once verified by biometrics. A current sample as well as a stored sample would be used to realize the system. Once the biometric verification occurs, the player would be granted access to the system and the implementation of known control data, taught by Crevelt above, would also become part of the method to realize the functionality of the entire system.

Regarding claims 18 and 23, the disclosure above teaches of the system described above wherein a smart card is used to access the system and be employed the privileges of such a system. These cards are known in the art and it is further known in the art that these tracking/use cards are often required to remain in the system during the entire session or else termination will occur. One of ordinary skill in the art would understand the value of such a restriction in order to further security by requiring the user to have the card on hand at all time to prevent fraudulent use of such card as well as to restrict the user to a single machine at a single time to allow the system to better keep track of the user and their wagers to aid verification.

Regarding claims 22 and 29, the above combination of references teach and motivate a system wherein a player can only access a betting station when a chip card is matched to biometric data. Gressel supports the concept of establishing an actual purse in which one of ordinary skill in the art would be motivated to use in order to limit the amount of money allowed, as taught by Crevelt, or to limit the number of continuous transaction to the bank each time the

Art Unit: 3713

player wants money, as is known in the art to be desirable by limiting bandwidth traffic. As taught by Vuong et al., the money is thus transferred from a separate casino account managed by the croupier to the card wherein the player can bet and further receive winnings.

Regarding claim 31, it has been disclosed above that the cards have the ability to access a banking system and therefore one of ordinary skill in the art would understand that it would be obvious to use an ADSL to implement the communication link as it would provide the necessary security features for transmitting such sensitive information. It is known that banks use such lines and the incorporation of such into the above-disclosed system would thus be obvious.

Regarding claim 32, the claimed biometric verification features are notoriously well known in the art and would have been enabled and obviated by the biometric verification disclosed by Stock et al.

Regarding claims 33 and 34, such items are a graphical design choice of information presentation. It is notoriously well known in the art to display bet and card information to a user of a computer gambling game. One of ordinary skill in the art would be motivated to use such pop ups and information screens to allow a player to view their bet information in order to verify their information as well as to actively participate in the game by being able to view the cards and still maintain a sense of actually being in the game. Such screens are known in remote gaming to allow the player to participate while at the same time informing the player of needed information as is known in the art.

Response to Arguments

Applicant's arguments regarding the timing of Vuong is not convincing. A mere allegation that because an element was known at the time of an invention makes it an

Art Unit: 3713

unobvious improvement to that invention is not convincing. The mere fact that Smart Cards existed at the time of Vuong does not negate the fact that they remain obvious to the Vuong system for the reasons presented above by the Examiner. Just because an inventor chooses not to include a feature does not detract from the fact that it would have been obvious to do so to a skilled artisan.

Regarding the Applicant's contention that because credit and debit applications can limit their transactions, they are not purses, the Examiner respectfully disagrees. The argument is not coterminous with that which is being claimed, as there is no mention of overcoming limits. Further, the applications still allow all the features that are required from the claims and thus meet the limitations of allowing the player to wager.

Conclusion

The Applicant's contention that because the Examiner listed references that were not applied, the Examiner recognizes the clear patentability of these references is incorrect. It is the policy of the Office to only provide the best possible rejection, not every possible rejection. Thus, just because a references is cited and not used does not translate to the Examiner admitting the limitations are patentable over the references disclosures.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Marks whose telephone number is (703)-305-7497. The examiner can normally be reached on Monday - Thursday (7:30AM - 5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (703)-308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3713

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


cmm
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